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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,652	08/14/2001	Kevin Burgess	17575.0661	7332

7590 06/18/2002  
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EXAMINER

SAKEB, ARIS, SALLY A

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 06/18/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/880,652

Applicant(s)

BURGESS ET AL.

Examiner

Sally A Sakelarlis

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 13-58 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_

*Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims 13-19 are drawn to a method of making a fluorescent dye useful to attach to a biomolecule as classified in for example, Class 435 subclass 287.1.

II. Claims 20-32 are drawn to a method of labeling a biomolecule with a fluorescent dye comprises a UV absorbing chromophore and a fluorescent emitter as classified in for example, Class 536, subclass 26.6.

III. Claims 33-43 are drawn to a method of labeling a biomolecule with a fluorescent dye comprising an anthracene derivative and BODIPY fragment as classified in for example, Class 536, subclass 25.32.

IV. Claims 44-58 are drawn to a method of detecting a biomolecule as classified in for example, Class 422, subclass 82.07.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II, I and III, I and IV, II and III, II and IV, and III and IV are drawn to patentably distinct methods which involve different method steps, include different reagents and have different objectives. Invention I includes a method of making a fluorescent dye wherein the steps involve linking a chromophore and emitter via a twisted pi-conjugated system. Invention II includes a method of labeling a biomolecule and involves the steps of conjugating a UV absorbing chromophore and a fluorescent emitter comprising a through bond energy transfer. Invention III includes a method of labeling a biomolecule and involves the steps of conjugating an anthracene derivative and a BODIPY fragment to each other. Lastly, Invention IV includes a

method of detecting a biomolecule involving the steps of detecting the dye of the labeled biomolecule. Therefore, the methods are distinct over one another.

3. Applicant is advised that the reply to this requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

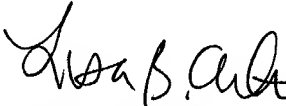
5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Sally Sakelaris whose telephone number is (703) 306-0284. The examiner can normally be reached on Monday-Friday from 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W.Gary Jones, can be reached on (703)308-1152. The fax number for the Technology Center is (703)305-3014 or (703)305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to Chantai Dessau whose telephone number is (703)605-1237.

Sally Sakelaris

6/17/02

  
LISA B. ARTHUR  
PRIMARY EXAMINER  
GROUP 1800/1600